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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,453	06/26/2003	James H. Layer	GSS-101-CP1	2961
35996	7590	12/13/2004	EXAMINER	
GMP COMPANIES, INC. ONE EAST BROWARD BLVD. SUITE 1701 FORT LAUDERDALE, FL 33301			PRICE, CARL D	
			ART UNIT	PAPER NUMBER
			3749	
DATE MAILED: 12/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/606,453	LAYER ET AL.
	Examiner	Art Unit
	CARL D. PRICE	3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06/26/2003 (preliminary amendment).  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 42-67 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 42,43 and 45-67 is/are rejected.  
 7) Claim(s) 44 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 09/26/2003.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Information Disclosure Statement**

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### **Drawings**

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the magnetically attractive member connected to the container adjacent the housing wherein movement of the container in relation to the housing causes movement of the magnetic member and flexing of the spring (claim 44) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Specification**

The disclosure is objected to because of the following informalities:

On page 1, in the first paragraph, applicant should update the information referencing related applications.

Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 62-65: Rejected under 35 U.S.C. 102(b)**

Claims 62-65 are rejected under 35 U.S.C. 102(b) as being anticipated by us005230216a (SIEGEL).

US005230216A (SIEGEL) shows and discloses a remotely operating a magnetic member (26) attached to a spring (35) near a distal end, wherein movement of an externally, or remotely, located magnetically attractive member (37) near the magnetic member causes movement of the magnetic member and flexing of the spring to initiate activation of an activatable substance. The heater of US005230216A (SIEGEL) is known to be used with containers, such as, "pitchers" which are known to have include hinged lids and spouts. US005230216A (SIEGEL) shows and discloses a substantially nonferrous (see column 2, line38) container/housing (14) for holding a material to be warmed.

In regard to claim 65, the recitations “for holding a surgical fluid in a relatively warm state” and “to hold a preselected amount of surgical fluid” are deemed to be recitations of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 43, 45-61, 66, 67: Rejected under 35 U.S.C. 103(a)**

Claims 43, 45-61, 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP01-274838 in view of us005230216a (SIEGEL).

JP01-274838 shows and discloses apparatus for generating heat for heating a fluid, comprising:

- a covered (41; 55: ) container (e.g. - 51) for holding a material to be warmed;
- a chamber (at 44) disposed about the container;
- a removable (see 42, 43) activatable heating substance (e.g. – 44,52) disposed within the chamber; and,
- means for initiating the activation of the activatable heating substance, the means comprising:
  - o a flexible coil spring (11; 12, 40, 50, etc.) disposed in the activatable heating substance, the spring being fixed near a proximal end, an actuator member (46) attached to the spring near a distal end, wherein movement of the actuator member causes movement and flexing of the spring to initiate the activation of the activatable heating substance.

JP01-274838 discloses the invention substantially as set forth in the claims with possible exception to:

- the use of a magnetic member, attached to the spring near a distal end, wherein movement of a magnetically attractive member near the magnetic member causes movement of the magnetic member and flexing of the spring to initiate the activation of the activatable heating substance;
- the activatable heating substance produces heat sufficient to maintain the material above room temperature for at least about 2 hours, at least about 4 hours, and/or, for example, the activatable heating substance comprises about 1250 milliliters of supercooled sodium acetate solution having a concentration of about 17.68 molar, which substance upon activation produces heat sufficient to warm about 800 milliliters of material at about 68.5 degrees Fahrenheit to a temperature between 95 and 120 degrees Fahrenheit and maintain it between 95 and 120 degrees Fahrenheit for at least about 2 hours;
- the container comprises one of polypropylene, nylon, polyethylene, vinyl, stainless steel, and titanium;
- at least a portion of the apparatus is sterilizable;

US005230216A (SIEGEL) teaches, from the same portable heat generator (see column 1, lines 6-30) field of endeavor as JP01-274838, remotely operating a magnetic member (26) attached to a spring (35) near a distal end, wherein movement of an externally, or remotely, located magnetically attractive member (37) near the magnetic member causes movement of the magnetic member and flexing of the spring to initiate activation of an activatable substance. The

heater of US005230216A (SIEGEL) is known to be used with containers, such as, "pitchers" which are known to have hinged lids and spouts.

In regard to claim 42, for the purpose of remotely operating the means for initiating activation of JP01-274838, it would have been obvious to a person having ordinary skill in the art to modify the spring and housing of JP01-274838 to include a magnetic member attached to the spring near a distal end such that an externally, or remotely, located magnetically attractive member causes movement of the magnetic member and flexing of the spring, in view of the teaching of us005230216a (SIEGEL).

Also, in regard to claims 51-57, since the selection and relative proportions of a given heating material(s), the heating time, etc. would depend on numerous design concerns such as the type of material being heated and the overall size and shape of the container, compartment, insulation layer, etc., to form the heating material according in the manner set forth in the claims can be viewed as nothing more than a mere matter of choice in design absent the showing of any new or unexpected results produced therefrom over the prior art of record.

In regard to claims 55 and 57, Official Notice is taken that it is well known to make containers from the materials set forth in applicant's claims and to make containers from materials capable of being sterilized. Thus, in view of that which is well known in the art, it would have been obvious to a person having ordinary skill in the art to make the apparatus of JP01-274838 from a sterilizable material.

**Allowable Subject Matter**

Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**USPTO CUSTOMER CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is (571) 272-4880. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on (571) 272-4877. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CARL D. PRICE  
Primary Examiner  
Art Unit 3749

CP